



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20531
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 485,002	01 31 2000	KOJI NAKATA	1776-4054	1376

7590 02 27 2002

DARRYL H STEENSMA
MORGAN & FINNEGAN
345 PARK AVENUE
NEW YORK, NY 10154

EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
----------	--------------

1773

1773

DATE MAILED: 02 27 2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/485,002

Applicant(s)

NAKATA ET AL.

Examiner

Vivian Chen

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2002.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-67 is/are pending in the application.
- 4a) Of the above claim(s) 25-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 1-17 have been cancelled by Applicant.

Continued Prosecution Application

2. The request filed on 1/11/2002 for a divisional Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/485,002 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 18, the phrases "polylactic acid-based" and "polycaprolactone-based" is vague and indefinite because it is unclear what constitutes polylactic acid- or polycaprolactone- "based".

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Application/Control Number: 09/485,002

Art Unit: 1773

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over MATSUDAIRA ET AL (US 6,096,431) in view of WNUK ET AL (US 5,939,467).

MATSUDAIRA ET AL discloses a biodegradable card comprising a base material containing a polylactic acid copolymer or homopolymer having a molecular weight of 10,000-1,000,000 and up to 20 wt% additional biodegradable polymers such as an aliphatic polyester having a molecular weight of 10,000-100,000 and/or a polycaprolactone having a molecular weight of 10,000-100,000, and optionally up to 50 wt% filler such as calcium carbonate or mica, wherein the card has a magnetic or other information recording layer (line 63, col. 3 to line 10, col. 4; line 29, col. 4 to line 24, col. 5; lines 46-68, col. 5; lines 4-38, col. 6) as recited in claims 18-24.

WNUK ET AL discloses that it is well known in the art to utilize combinations of three or more biodegradable polymers such as a blend containing aliphatic polyester, polycaprolactone, and a polylactide (lines 23-53, col. 3) in order to produce films and other conventional articles with an optimum balance of processibility, mechanical properties, and durability for specific applications.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize multiple modifying biodegradable polymers in the polylactic acid base layer material of MATSUDAIRA ET AL and adjust the relative proportions of the various

modifying polymers in order to obtain the desired mechanical properties and/or durability characteristics required for specific applications.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

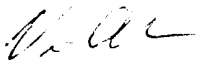
EUROPEAN PATENT APPLICATION EP 0 890 614 A1 discloses a biodegradable card material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (703) 305-3551. The examiner can normally be reached on Monday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3601.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

February 25, 2002


Vivian Chen
Primary Examiner
Art Unit 1773